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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,386	12/28/1999	MARIO GUILLEN	BAL6019P0090	9922

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EXAMINER

HWU, JUNE

ART UNIT PAPER NUMBER

1661

DATE MAILED: 05/21/2002

LD

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,386

Applicant(s)

GUILLEN, MARIO

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input checked="" type="checkbox"/> Other: See Continuation Sheet. |

Continuation of Attachment(s) 6). Other: Decision on petition for color drawings-attached.

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DETAILED ACTION

The continued prosecution application filed March 25, 2002 is hereby acknowledge as paper number 16. The preliminary amendment (paper number 17) and petition for color drawings (paper number 15) received on March 25, 2002 have been entered.

Drawings

The petition for color drawings has been approved.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Plant Patent No. 12,588. Although the conflicting claims are not identical, they are not patentably distinct from each other because The claims in the present application and patent are drawn to the instant plant *Impatiens* 'Balfafusia' wherein the plants, pollen, ovule, and regenerable tissues are inherent from the parent application. The subject matter of the instant claims 19-22 is encompassed by claim 1 of U.S. Plant Patent No. 12,588.

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The terminal disclaimer filed on August 15, 2001 is not proper because the serial of the application, which forms the basis for the double patenting, do not match the instant application. Applicant stated that the terminal disclaimer enclosed is a copy and is not required in the present application. This argument is not persuasive because Applicant is directed to MPEP 804.02, which states, "If an appropriate double patenting rejection of the nonstatutory type is made in two or more pending applications, an appropriate terminal disclaimer **must be filed in each application.**"

Claim Rejections - 35 USC § 112

Applicant's amendment filed March 25, 2002 failed to address the following new grounds of rejection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Written Description

Claims 13-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 13-30 are drawn to a trailing interspecific impatiens plant by crossing *Impatiens flaccida* with *Impatiens hawkeri* and its progeny. However, the specification only discloses the crossing of *Impatiens flaccida* with *Impatiens hawkeri* resulting in a progeny with a trailing habit such as 2245B. There are no other examples given with this combination.

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In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. It is not realistic to expect that the "complete structure" of the trailing impatiens plant could be described. Therefore the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotypes of all the claimed interspecific impatiens have been described. In this case, the few disclosed embodiments are not representative of the enormous number of products claimed. The Impatiens species have many phenotypic characteristics, which vary independently. Impatiens species can differ in growth habit, leaf color, flower morphology, and other characteristics. For example, *Impatiens flaccida* can grow between 20-70 cm in height with deep green leaf color (page 650) while *Impatiens hawkeri* grows about 11 cm with green tinged with bronze, yellow or pink along the midribs (page 650). The claims encompass impatiens having one fixed characteristic, low or procumbent habit, however, an enormous number of other undisclosed phenotypic traits are not disclosed.

Next, then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. The limited disclosure in the specification is not deemed sufficient to reasonably convey to one skilled in the art that Applicant was in possession of the full scope of the genus recited in the claims at the time the application was filed. Thus it is concluded that the written description requirement is not satisfied for the claimed genus.

Enablement

Claims 19-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 19 employs novel plants, seeds and plant parts. Since the plants of 2245B is essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If it is not so obtainable or available, the requirements of 35 U.S.C. § 112, regarding "how to make" the invention may be satisfied by deposit. For the plant, a deposit of 2500 seeds is considered adequate to ensure availability of each claimed embodiment. The specification does not disclose a repeatable process to obtain the plants, seeds or plant parts, because it does not appear that the two parental lines are readily available to the public. Even if the parents were available, then the progeny would not be identical to the named plants unless they were both inbred lines. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific plant line has been deposited under the Budapest Treaty and that it will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If the deposit is not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809, applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

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(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer; and,

(d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and,

(e) the deposit will be replaced if it should ever become inviable.

Claims 20-24 are dependent on claim 19 and are rejected for reason stated above.

Applicant argues that 2245B can be produced from the parent lines, which are available to the public. However, this argument is not persuasive because there is no evidence that the parent lines are inbred. Sexual reproduction is a random process, and the odds against making the same genotype twice are vast. See page 5, first paragraph of specification. Therefore, the deposit of 2245B recited in the claims is required to enable the claims.

The applicant should deposit regenerable tissues of 2245B with a recognized depository of applicant's choice. See MPEP 2405.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-19 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17-19 and 29 are indefinite in the recitation "Asexual reproduced progeny". The phrase is unclear and may be obviate by stating, "Asexually reproduced progeny".

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Claim 19 is indefinite because it is unclear whether the interspecific impatiens plant is the 2245B or the progeny of 2245B.

Claims 23 and 24 remain rejected as being indefinite in its recitation of "Asexual progeny" as stated in the previous Office action (paper number 9, page 4).

Conclusion

All claims are free of prior art because the prior art did not teach or suggest an interspecific impatiens plants, 2245B, with a trailing habit.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (703) 308-5017. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 4:00 p.m. and off alternate Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

JH



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